

DAC/JE



Renewed Petition under 37 CFR 1.137(b)

08 April 2010

Mark R. Williams
682 S. 7th St.
San Jose CA 95112
re Application No. 09/652,387
Att. Dkt. No. 253/232

Attorney Alesia M. Brown
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Attorney Brown:

I am responding to your dismissal letter with mailing date of Mar 02 2010. I would like to request reconsideration of my petition to revive my application. I am enclosing a properly signed copy of the Reply originally filed June 19, 2004.

Please advise if any additional submission is necessary. My cell phone number is (408) 206-6910.

Sincerely,

A handwritten signature in black ink, appearing to read "Mark R. Williams".

Mark R. Williams

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OPAP IAP10

Request for TRADEMARK OFFICE

for

Continued Examination (RCE)

Transmittal

APR 12 2010

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	09/652,387
Filing Date	August 31, 2000
First Named Inventor	Mark R. Williams
Art Unit	2177
Examiner Name	Debbie M. Le
Attorney Docket Number	

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

- i. Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
ii. Other _____

- b. Enclosed

- | | |
|---|--|
| i. <input checked="" type="checkbox"/> Amendment/Reply | iii. <input type="checkbox"/> Information Disclosure Statement (IDS) |
| ii. <input type="checkbox"/> Affidavit(s)/ Declaration(s) | iv. <input checked="" type="checkbox"/> Other cover letter |

2. **Miscellaneous**

- a. Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a

- a. period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
b. Other _____

3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to

- a. Deposit Account No. _____.

- i. RCE fee required under 37 CFR 1.17(e)
ii. Extension of time fee (37 CFR 1.136 and 1.17)
iii. Other _____

- b. Check in the amount of \$ _____ enclosed

- c. Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature	<i>Mark R. Williams</i>	Date	4/8/10
Name (Print/Type)	Mark R. Williams	Registration No.	

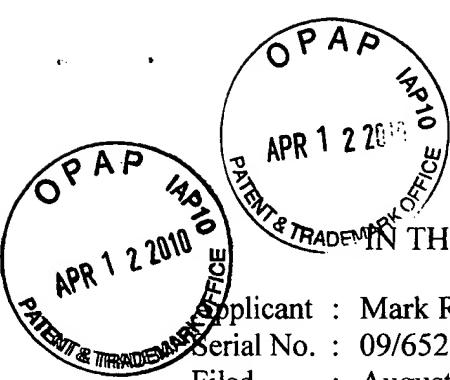
CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature	<i>Mark R. Williams</i>	Date	4/8/10
Name (Print/Type)	Mark R. Williams	Registration No.	

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mark R. Williams

Art Unit : 2177

Serial No. : 09/652,387

Examiner : Debbie M. Le

Filed : August 31, 2000

Title : METHODS AND APPARATUSES FOR MEDIA FILE DELIVERY

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY

Dear Patent Examiner:

I am writing you as inventor and filer of the above named patent application. I filed this application as a private individual. As I have now exhausted all my funds for patent attorneys to assist with this correspondence, I will try my best to respond on my own. I hope you will bear with me if I make format mistakes in this and future responses.

After again reviewing all the correspondence on this application, I believe there are just two points of misunderstanding that I can readily clear up. Rather than cite those here out of context, please allow me to quickly run through the invention first.

I. This invention was conceived to cover a very specific application for portable music players. Here is a brief overview of the use of the invention.

- The player unit is connected to a PC through typical means – a USB cable, for example – to download compressed music files (such as MP3 files). The invention does not involve encrypting or protecting the music files in any way.
- During installation of the transfer software on a PC, the identifier # of the player unit is transferred to the PC and stored in some non-volatile way (on the hard disk for example).
- During any subsequent music download, this identifier is attached to each downloaded music file to associate it only with that particular player unit. Note that the identifier is **not** related to the *content* of the music file – there are already industry-standard identifiers for MP3 files, for example, and there is no claim to inventing these.

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- The invention does nothing to prevent the music download, or to assure a "secure" transfer. However, during the music file transfer it additionally downloads to the player unit a file containing advertising messages, and uploads from the player unit a record of previous listening activity.
- After this download/upload activity, the player unit is disconnected from the network and has no further requirement for connection until the user wishes to download new audio files.
- When the user plays the music from the player unit, the invention does three things:
 1. It checks the identifier that was appended to the music file to determine whether it matches that of the player unit. If not, the music file may have come from another source. For example, the music file could have been downloaded from someone else's PC.
 2. If the music file didn't come from the player unit owner's PC, the player unit plays one of the brief (~3 sec long) advertising messages from the previously downloaded file just prior to playing the song.
 3. If the commercial message is played, the player unit takes note of the advertising message number, associates this with the industry-standard identifier that came with the downloaded music selection itself, and stores both in memory as a record of listening activity.
- Note that the player unit **cannot** prevent the audio file from playing back, regardless of whether an advertising message was played along with it.
- The next time the player unit is attached to the PC for music downloads, the above-mentioned record of previous listening activity is uploaded.
- Once uploaded to the PC, the listening activity information is sooner or later transferred back via network connection to a service that charges the advertiser for the commercial

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played, and pays the recording artist or company for the music heard. The user is unaware of and uninvolved in this activity. Moreover, the transfer of this information back to the service happens independently of the music download (probably in the background at a later time).

Unlike what is claimed in other patents, the user is **never** prevented from listening to music (even a pirated copy) and never signs up for any type of billing service or is in any way responsible for paying money for listening to the music.

II. Regarding the Berry patent as a basis for rejecting my claims:

One of the points of misunderstandings I mentioned earlier has to do with “commercial messages.” I am not talking about “commercial” as in “related to commerce” – I’m talking about advertisements – like ads on the radio. I believe that when re-read in this context, my claims are quite dissimilar to those of Berry.

In addition, Berry teaches about manipulating “identifiers”. But as made quite clear even in the Berry abstract, the patent offers:

“A method and system in a multimedia computer system for automatically retrieving and presenting data associated with an audio recording...”

The “identifiers” of my invention are **not** associated with the audio recording content. They serve only to indicate the ownership of the file, and have nothing to do with the file contents.

III. Regarding the Simmons patent as a basis for rejecting my claims:

This is the other point of misunderstanding. My invention never attempts to prevent audio playback, nor does it provide a means of charging the user a fee for the content.

- Simmons sections [0022] and [0040] talk about using an identifier for the purposes of “the requested file being uniquely dynamically encrypted such that it can only be played back on the requesting player/receiver...”. The purpose of the identifier on my invention

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is to determine whether an advertising message should be played, **not** to prevent playback of the content. This was not foreseen by Simmons.

- Simmons sections [0045] and [0049] focus on “encryption” of the media file to prevent the content from being played unless all conditions are met. My invention does **not** encrypt content files, since it does not want to prevent them from being played. The word “encryption” does not appear anywhere in my claims, because there is never any attempt made to secure the music.
- Simmons section [0050] focuses on the electronic transaction control mechanism designed to ensure that users pay for content. It uses an electronic serial number as part of this process. My invention does **not** require the user to pay for content. It uses the electronic serial number of the player unit for an entirely different purpose – to determine whether both the audio file and the player unit belong to the same user (the advertising messages are played if the numbers don’t match).

For Simmons to have foreseen my invention, it would have to allow download and unrestricted playback, of any content from any source, at no cost to the user. This is exactly the opposite of what Simmons intends.

In summary:

- Berry teaches how to retrieve additional information related to the audio file content.
- Simmons teaches how to determine whether the file content is allowed to be played back so as to ensure that the consumer pays for content.
- My patent teaches a way to let a content producer and an advertiser know that that advertiser’s message has been played in conjunction with that producer’s content, allowing the advertiser to compensate the content producer as appropriate.

My invention is using basic computer and networking concepts for an entirely different purpose than either Simmons or Berry.

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Summary of Changes to Claims

- Claim 1: Since the word "identifier" alone is getting confused with the definition used in the Berry patent, I have clearly defined this identifier as NOT the one Berry refers to (the industry-standard Redbook audio CD identifier).
- Claims 2 and 4: The changes to claim 1 should make claims 2 and 4 clear without additional changes.
- Claims 5, 6, and 7: The only Berry references to "messages" are to network messaging packets. Moreover, the Berry patent doesn't teach anything about commercial advertisements. I have added the word "advertising" to claims 5 and 6 to make it clear that all "messages" referenced are advertising messages. I've canceled claim 7 because it is now redundant.
- Claims 9 and 10: The real purpose of the invention is to handle audio files. For simplicity I'm canceling the claims for video and text files.
- Claims 11, 13, 14, 15: I've amended or canceled these for the reasons given above for claims 5, 6, and 7.
- Claims 17 and 18: Canceled for the same reasons as given above for claims 9 and 10.

I ask that all claims be allowed in view of the amendments to the claims contained on the following sheets, a total of 5 pages.

Respectfully submitted,

Date: 6/19/2004

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In the claims:

Please amend the claims as follows:

1. (currently amended) A method for uniquely marking a media file, comprising:
receiving a media file; and
appending an-a player unit identifier onto the media file that is unrelated to the media file content.
2. (unchanged)
3. (previously canceled)
4. (unchanged)
5. (currently amended) The method of claim 1, further comprising receiving an advertising message file.
6. (currently amended) The method of claim 5, wherein the media file and the advertising message file arrive in a concatenated state.
7. (canceled)
8. (unchanged)
9. (canceled)
10. (canceled)

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11. (currently amended) A method for delivering an advertising message file, comprising:

receiving a media file with a first identifier, wherein the first identifier uniquely identifies a player unit;

retrieving a second identifier, wherein the second identifier also uniquely identifies a player unit;

comparing the first identifier with the second identifier to determine whether the player unit identified by the first identifier is the same as the player unit identified by the second identifier;

retrieving an advertising message file and producing an advertising message output from the advertising message file if the first identifier does not correspond to the second identifier; and

producing a media output from the media file.

12. (unchanged)

13. (currently amended) The method of claim 11, wherein the step of retrieving an advertising message file comprises retrieving an advertising message file from a storage device.

14. (currently amended) The method of claim 11, wherein the step of retrieving an advertising message file comprises retrieving an advertising message file from a non-volatile memory.

15. (canceled)

16. (unchanged)

17. (canceled)

18. (canceled)

19. (unchanged)

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20. (unchanged)
21. (currently amended) The method of claim 11, wherein the media file and the advertising message file are in a concatenated state.
22. (currently amended) The method of claim 11, wherein if the advertising message file cannot be retrieved, then the step of producing a media output is not carried out.
23. (currently amended) A player unit for delivering media files, comprising:
 - a processor;
 - a non-volatile memory communicatively coupled to the processor;
 - a first identifier stored in the non-volatile memory, wherein the first identifier uniquely identifies the player unit;
 - a communications port communicatively coupled to the processor and capable of communicatively coupling the player unit to a computer system;
 - a data storage drive communicatively coupled to the processor and capable of transferring data between the player unit and a removable data storage medium;
 - a first application program residing in the player unit and accessible by the processor, the application program comprising one or more sequences of instructions for uniquely marking a media file, the one or more sequences of instructions causing the processor to perform a number of acts, said acts comprising:
 - receiving a media file,
 - retrieving the first identifier from the non-volatile memory,
 - appending the first identifier onto the media file, and
 - storing the appended media file in the removable data storage medium;
- and
 - a second application program residing in the player unit and accessible by the processor, the application program comprising one or more sequences of instructions for delivering an advertising message file, the one or more sequences of instructions causing the processor to perform a number of acts, said acts comprising:
 - receiving a media file with a second identifier, wherein the second

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identifier uniquely identifies a player unit,

comparing the second identifier to the first identifier to determine whether the player unit identified by the second identifier is the same as the player unit identified by the first identifier,

retrieving an advertising message file from the non-volatile memory and producing an advertising message output from the advertising message file if the second identifier does not correspond to the first identifier, and producing a media output from the media file.

24. (currently amended) A player unit for delivering files, comprising:

a first logic circuit configured to perform a number of acts, said acts comprising:

receiving a media file,

retrieving a first identifier that uniquely identifies the player unit,

appending a representation of the first identifier onto the media file, and

storing the appended media file in a removable data storage medium;

a second logic circuit configured to perform a number of acts, said acts comprising:

receiving a media file with a second identifier, wherein the second identifier uniquely identifies a player unit

comparing the second identifier to the first identifier to determine whether the player unit identified by the second identifier is the same as the player unit identified by the first identifier,

retrieving an advertising message file from the non-volatile memory and producing an advertising message output from the advertising message file if the second identifier does not correspond to the first identifier, and

producing a media output from the media file;

a non-volatile memory communicatively coupled to the logic circuits for storing the first identifier;

a communications port communicatively coupled to the logic circuits and capable of communicatively coupling the player unit to a computer system; and

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a data storage drive communicatively coupled to the logic circuits and capable of transferring data between the player unit and a removable data storage medium.

25. (unchanged)

26. (unchanged)

27. (unchanged)